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10/052,076	01/16/2002	Dan Kikinis	P1553D2	3459

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EXAMINER

WINDER, PATRICE L

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/052,076

**Applicant(s)**

KIKINIS, DAN

**Examiner**

Patrice Winder

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,055,566. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent and the application are claiming common subject matter, as follows: a playback unit that receives and stores text documents and renders the text documents in speech on demand.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 recites the limitation "the text documents" in line 5. There is insufficient antecedent basis for this limitation in the claim.

5. Claim 1 recites the limitation "the subscriber's computer" in line 10. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 6, and 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Schulhof et al., USPN 5,841,979 (hereafter referred to as Schulhof).

8. As to claim 1, Schulhof taught an information delivery system comprising:

an Internet-connected host server adapted to compile information from information sources and deliver the information as electronic documents via the Internet (distribution/delivery system 10, col. 3, lines 59-61, col. 4, lines 3-5, col. 8, lines 8-11);

a subscriber's Internet Appliance (IA) connected to the Internet and adapted to download the text documents from the Internet-connected server (user order entry module 21, col. 4, lines 38-41, 53-56); and

a playback unit connectable to the subscriber's IA via a data link (user module 71, col. 4, lines 43-44, col. 11, lines 3-8);

wherein the playback unit is adapted to receive and store the electronic documents while connected to the subscriber's computer, and to render the electronic documents as speech on demand when not connected to the subscriber's computer (col. 6, lines 40-62).

9. As to dependent claim 2, Schulhof taught wherein the information is sent to the host server from the information sources over one or more data links (col. 4, lines 13-17).

10. As to dependent claim 3, Schulhof taught wherein the electronic documents are delivered from the information sources to the host server over the Internet (col. 4, lines 13-17, col. 5, lines 44-48).

11. As to dependent claim 6, Schulhof taught comprising a radio broadcast system coupled to the host server and a radio receiving unit in the playback unit, the broadcast system and receiving unit adapted to update information according to subscriber preferences in the playback unit with the playback unit disconnected from the subscriber's IA (col. 5, lines 37-42, col. 6, lines 22-26, col. 14, lines 55-57).

12. As to claim 8, Schulhof taught a portable playback unit (control module 100, col. 10) comprising:

data port for connecting to an Internet Appliance (IA) (col. 11, lines 3-8);

memory for storing text documents downloaded from the IA via the data port (col. 6, lines 40-51);

a speaker (speaker 124, col. 10, lines 53-55); and

text-to-speech system adapted to open electronic documents downloaded from the IA, and to render the electronic documents as speech via the speaker (col. 6, lines 55-65).

13. As to dependent claim 9, Schulhof taught further comprising user inputs for controlling selection of documents for playback, and start and stop functions for playback ("program select" 127, "pause/resume" 121, col. 10, lines 49-52, 55-56).

14. As to dependent claim 10, Schulhof taught further comprising a radio antenna and receiving circuitry, wherein the unit is adapted to receive electronic documents by radio to be stored and later rendered as speech (col. 14, lines 55-57).

15. As to dependent claim 11, Schulhof taught further comprising an LCD display adapted to display control functions for operating the playback unit (display 150, 152, col. 11, lines 12-18).

### ***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 4, 7, 13 and 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Schulhof in view of Logan et al., U.S. Patent No. 5,721,827 (hereafter referred to as Logan).

18. As to dependent claim 4, Schulhof does not specifically teach wherein the host server is adapted to store subscriber preferences and to sort information for delivery to subscribers according to the preferences. However, Logan taught wherein the host server is adapted to store subscriber preferences and to sort information for delivery to subscribers according to the preferences (col. 5, lines 13-36). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Logan=s use of preferences in Schulhof=s information delivery system would have increased system effectiveness by reducing the number of possible choices while increasing the relevance of the possible choices to the subscriber. The motivation would have been to enable the host server to tailor the information delivery to the tastes of the subscriber (Logan, Background of the Invention).

19. As to dependent claim 7, Schulhof does not specifically teach wherein the host server is adapted to adjust stored subscriber preferences according to subscriber use patterns. Logan taught wherein the host server is adapted to adjust stored subscriber preferences according to subscriber use patterns (col. 16, line 58 - col. 17, line 4). See paragraph number 16, above for motivation.

20. As to claim 13, Schulhof taught a method for providing information to a subscriber, comprising steps of:

- (a) collecting information at an Internet-connected server from plural information sources (col. 4, lines 13-17);

- (d) downloading the electronic documents from the subscriber's IA to a connected playback device (user order entry module 21, col. 4, lines 38-41, 53-56); and

(e) disconnecting the playback device from the IA (user module 71, col. 4, lines 43-44, col. 11, lines 3-8); and

(f) playing back the electronic documents to a speaker at the playback device by a text-to-speech system (control module 100, col. 6, lines 55-65).

Schulhof does not specifically teach providing filtered information to a subscriber. However, Logan taught a method of providing filtered information to a subscriber, comprising: (b) sorting the information according to subscriber preferences (col. 5, lines 13-36);

(c) sending information sorted for a specific subscriber as electronic documents to that subscriber's Internet Appliance (IA) via the Internet (col. 6, line 65 - col. 7, line 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Logan's method of providing filtered information in Schulhof's information delivery system would have increased system effectiveness by reducing the number of possible choices while increasing the relevance of the possible choices to the subscriber. The motivation would have been to enable the host server to tailor the information delivery to the tastes of the subscriber (Logan, Background of the Invention).

21. As to dependent claim 15, Schulhof taught including a step for sending electronic document updates from the Internet-connected server by radio transmitter, and for receiving electronic document updates at the playback device by radio receiver, with the playback device disconnected from the subscriber's IA (col. 5, lines 37-42, col. 6, lines 22-26, col. 14, lines 55-57).



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22. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schulhof in view of Michael H. O'Malley, Text-To-Speech Conversion Technology (hereafter referred to as O'Malley).

23. As to dependent claim 5, Schulhof does not specifically teach wherein the host server is adapted to code electronic documents delivered to a subscriber in a manner to control audio characteristics including inflection as the text documents are rendered as speech in the playback unit. However, O'Malley taught wherein the host server is adapted to code electronic documents delivered to a subscriber in a manner to control audio characteristics including inflection as the text documents are rendered as speech in the playback unit (prosody rules, page 21). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating O'Malley's coded text in Schulhof's information delivery system would increased system effectiveness by enhancing the text-to-speech conversion system such that the conversion is not as robotic. The motivation would have been to enable the speech to sound as natural as possible.

24. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schulhof.

25. As to dependent claim 12, Schulhof does not specifically teach the portable playback unit further comprising a battery and recharge circuitry, the battery adapted to provide electrical power to the playback unit disconnected from the IA and the recharge circuit adapted to recharge the battery with the unit connected to the IA. However, "official notice" is taken that some portable units, such as cellular phones, comprise a

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battery and recharge circuitry. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating a battery and recharge circuitry would have increased effectiveness of the portability of the unit by enabling the system to be powered remotely. The motivation would have been because portable units with a battery and recharge circuitry are well known in the art.

26. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schulhof and Logan as applied to claim 13 above, and further in view of O'Malley.

27. As to dependent claim 14, Schulhof does not specifically teach a step for coding the text in an electronic document at the Internet-connected server in a manner to control speech characteristics, including inflection, during text-to-speech rendition at the playback device. However, O'Malley taught further comprising a step for coding the text in an electronic document at the Internet-connected server in a manner to control speech characteristics, including inflection, during text-to-speech rendition at the playback device (prosody rules, page 21). See paragraph number 21, above for motivation.

### ***Conclusion***

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Logan et al., U.S. Patent No. 5,732,216: taught an audio program and message distribution system in which a host system organizes and transmits program segment to

client subscriber locations, a playback unit at the subscriber location reproduces the program segments;

Davis et al., U.S. Patent No. 5,796,952: taught a method and apparatus for tracking client interaction with a network resource by monitoring information and client identifying indicia stored on a database and for automatically serving out files assembled according to user interests and preferences;

Wise et al., U.S. Patent No. 5,884,262: taught a computer document audio access and conversion system which allows a user to access information originally formatted for audio/visual interfacing, such as an HTML document, by a telephone.

Rappaport et al., U.S. Patent No. 5,890,152: taught a personal feedback browser for obtaining media files, wherein a sound-to-text software program is provided for translating a sound file to a text file;

Hunt et al., U.S. Patent No. 5,893,091: taught a method for distributing timely information over a computer network where a Timely Information Server collects and organizes information from Timely Information Providers and then broadcasts the organized information to endusers; and

Simon Arnfield, World Class Synthesis of Prosodic Annotations: taught a computer program that can annotate unseen text with prosodic stress and tone marks using the sequence of part of speech tags assigned by a tagging system.

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is (703) 305-

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3938. The examiner can normally be reached on Monday-Friday from 10:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam, can be reached on (703) 308-6662. The fax phone number for this Group is (703) 308-9052.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
**PATRICE WINDER**  
**PRIMARY EXAMINER**